REMARKS

The Office Action mailed July 17, 2002, has been received and reviewed. Claims 1-19 are currently pending in the application. Claims 1-19 stand rejected. The drawings are objected to as failing to comply with 37 C.F.R. 184(p)(5). Appropriate correction of the drawings has been made. Applicant has amended claims 1, 2, 8, 10, 17, and 19 and respectfully requests reconsideration of the application as amended herein.

I. Drawings

FIGs. 1-4 have been amended to include reference numeral "2" and appropriate lead lines. Applicant has deleted reference numeral "4" from the specification, rendering this objection moot.

II. 35 U.S.C. § 112 Rejection

Claim 8 stands rejected under 35 U.S.C. §112, ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Applicant has amended claim 8 and respectfully requests withdrawal of the §112, ¶2 rejection.

III. 35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on United States Patent No. 5,424,523 to Ohno *et al.*

Claims 1-3, 5, 7-9, and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,424,523 to Ohno *et al.* ("Ohno"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

As amended herein, claim 1 is not anticipated by Ohno because Ohno does not describe each and every element of the claim. Ohno discloses a record medium

having two magnetic record layers. The record medium is a pre-printed ticket that is fed through a ticket machine to visualize the magnetic information on the magnetic record layers. However, Ohno does not disclose a magnetic layer that comprises a layer of homogenous, magnetic material. To the extent that the magnetic record layers are mentioned in Ohno, only the required coercive forces and residual magnetic fluxes of these magnetic record layers are disclosed. (Column 5, lines 17-22.) Ohno is completely silent about the types of magnetic materials used and the form in which the magnetic record layers are present. Since Ohno does not disclose that its magnetic record layers comprise a layer of homogenous, magnetic material, Ohno does not describe the magnetic layer of the present invention as recited in claim 1.

Ohno also does not disclose an ink receptive layer that absorbs laser or inkjet ink. To the extent that Ohno discloses an ink receptive layer, Ohno only discloses that the information on the ticket is printed using a "heat-transfer recording system." Column 5, lines 12-14. Ohno is silent about any other details regarding its ink receptive layer and, therefore, does not disclose that its ink receptive layer absorbs laser or inkjet ink. Ohno also does not disclose that information is printed using a laser or inkjet printer. Furthermore, the record medium of Ohno is not adapted for use in a laser or inkjet printer. In other words, this record medium is not a print medium that can be used in a laser or inkjet printer. Rather, this ticket is pre-printed with information and magnetic information that is recorded on the magnetic record layers using a heat transfer recording system.

Claims 2, 3, 5, and 7-9 are allowable, *inter alia*, as depending on allowable claim 1.

Claim 2 is further allowable because Ohno does not disclose a base layer that supports the magnetic printing media as it is transported through a laser printer or an inkjet printer.

Claim 3 is further allowable because Ohno does not disclose a base layer having a printable surface.

Claim 5 is further allowable because Ohno does not disclose a base layer and an ink receptive layer both adapted to receive laser or inkjet ink.

Claim 8 is further allowable because Ohno does not disclose magnetically encoded information that is textual and graphical information.

Claim 9 is further allowable because Ohno does not disclose a magnetic layer adhered to a base layer or an ink receptive layer adhered to a magnetic layer.

Claim 17, as amended herein, is not anticipated by Ohno because Ohno does not describe each and every element of the claim. Specifically, Ohno does not disclose adhering a magnetic layer to a base layer and adhering an ink receptive layer to the magnetic layer. In addition, Ohno does not disclose printing information on the ink receptive layer using an inkjet printer or a laser printer. Instead, as discussed in detail in the § 102 rejection of claim 1, Ohno only discloses using a heat-transfer recording system to print the information.

Claims 18 and 19 are allowable, *inter alia*, as depending on allowable claim 17.

Claim 19 is further allowable because Ohno does not disclose transporting the magnetically encoded, printed document through an inkjet or laser printer.

In view of the foregoing arguments, reconsideration and withdrawal of the § 102 rejections of claims 1-3, 5, 7-9, and 17-19 is respectfully requested.

IV. 35 U.S.C. § 103(a) Obviousness Rejections

Claims 4, 6, 10-15, and 16 stand rejected under 35 U.S.C. § 103(a) ("Section 103") as being unpatentable over various combinations of Ohno in view of United States Patent No. 5,916,673 to Fryberg *et al.* ("Fryberg"), United States Patent No. 5,747,156 to Hashiba *et al.* ("Hashiba"), and United States Patent No. 4,114,032 to Brosow *et al.* ("Brosow"). Applicant respectfully traverses these rejections, as hereinafter set forth. M.P.E.P. 706.02(j) sets forth the standard for a Section 103 rejection:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First,
> there must be some suggestion or motivation, either in the references themselves or in the
> knowledge generally available to one of ordinary skill in the art, to modify the reference
> or combine reference teachings. Second, there must be a reasonable expectation of
> success. Finally, the prior art reference (or references when combined) must teach or
> suggest all the claim limitations. The teaching or suggestion to make the claimed

> combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The examiner bears the heavy burden of establishing a *prima facie* case of obviousness.

Obviousness Rejection Based on Ohno in view of Fryberg

Claim 4 stands rejected under Section 103 as being unpatentable over Ohno in view of Fryberg. Applicant respectfully submits that the rejection of claim 4 is improper because Ohno and Fryberg do not teach or suggest all the limitations of claim 4 and do not provide a suggestion or motivation to combine to produce the claimed invention.

Claim 4 depends from claim 1 and, therefore, includes all the limitations of claim 1. As previously discussed in the anticipation rejection of claim 1, Ohno does not teach or suggest all the limitations of claim 1. Specifically, Ohno does not teach or suggest a magnetic printing medium that comprises a magnetic layer having a layer of homogenous, magnetic material. Ohno also does not teach or suggest an ink receptive layer that absorbs laser or inkjet ink. Rather, Ohno is drawn to a ticket having information pre-printed on its ink receptive layer using a heat-transfer recording system. The ticket is then encoded with magnetic information on its magnetic recording layers. Ohno does not teach or suggest a blank printing medium that is used in an inkjet or laser printer.

Fryberg does not cure these deficiencies in Ohno because Fryberg does not teach or suggest a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink. Therefore, Applicant respectfully submits that the cited references do not teach or suggest all the limitations of claim 4.

The cited references also do not provide a suggestion or motivation to combine. The Examiner states that it would have been obvious to combine Ohno and Fryberg "to retain the printing received on the ink surface that would diminish over time without the use of the coating." Office Action of

July 17, 2002, page 4. However, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. Nothing in Ohno and Fryberg suggests the desirability of having at least one ink receptive layer that comprises a surface coated onto the ink receptive layer to increase the ink receptivity of the surface. Ohno and Fryberg are not in analogous arts because Ohno is drawn to a magnetic record medium while Fryberg is drawn to a print medium.

Furthermore, contrary to the Examiner's stated motivation, nothing in Ohno and Fryberg suggests the desirability of using a surface coated onto the ink receptive layer to retain printing on the ink receptive layer. Finally, even if Ohno and Fryberg were combined, the claimed invention would not be produced because the resulting magnetic printing media would not have a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink. Additionally, Ohno teaches away from the resulting combination because it discloses use of a heat transfer method to record images on the ticket.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejection to claim 4 is respectfully requested.

Obviousness Rejection Based on Ohno in View of Hashiba

Claim 6 stands rejected under Section 103 as being unpatentable over Ohno in view of Hashiba. Applicant respectfully submits that the Section 103 rejection of claim 6 is improper because Ohno and Hashiba do not teach or suggest all the limitations of claim 6 and do not provide a suggestion or motivation to combine to produce the claimed invention.

Claim 6 depends from claim 1 and, therefore, includes all the limitations of claim 1. As previously discussed, Ohno does not teach or suggest all the limitations of claim 1. Hashiba does not cure the deficiencies in Ohno because Hashiba does not teach or suggest a magnetic printing medium having a magnetic layer comprising a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or

inkjet ink. Therefore, Applicant respectfully submits that the cited references do not teach or suggest all the limitations of claim 6.

In addition to not teaching or suggesting all the limitations of claim 6, the cited references do not provide a suggestion or motivation to combine. The Examiner states that it would be obvious to modify Ohno "to provide the magnetic material selected from material comprising a metal or alloy, as taught by Hashiba." Office Action of July 17, 2002, page 5. However, the cited references do not suggest the desirability of such a combination. Nothing in Ohno suggests the desirability of using the recited materials in a magnetic printing media and Hashiba does not suggest the desirability of using the listed materials in a magnetic printing media. Furthermore, as previously discussed, even if Ohno and Hashiba were combined, the claimed invention would not be produced because the resulting magnetic printing media would not have a magnetic printing medium having a magnetic layer that comprises a layer of homogenous, magnetic material or an ink receptive layer that absorbs laser or inkjet ink.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejection to claim 6 is respectfully requested.

Obviousness Rejection Based on Brosow in View of Ohno

Claims 10-15 stand rejected under Section 103 as being unpatentable over Brosow in view of Ohno. Applicant respectfully submits that Brosow and Ohno do not teach or suggest all the limitations of the rejected claims and do not provide a suggestion or motivation to combine.

As amended herein, Claim 10, is not rendered obvious by the cited references because Brosow and Ohno do not teach or suggest all the limitations of claim 10. As previously discussed, Ohno does not teach or suggest that the magnetic layer comprises a layer of homogenous, magnetic material. Brosow does not teach or suggest this limitation because Brosow utilizes fibers or filaments coated with a magnetic or magnetizable material. These fibers are embedded in a base material and are not formed in a layer. Brosow and Ohno also do not teach or suggest that the base layer, magnetic layer, and ink receptive layer are adhered to one another. Rather,

Ohno is silent about how its layers are formed while the magnetic material in Brosow is embedded in the base material.

The Examiner asserts that Brosow discloses the claimed invention "except for the particular arrangement of the layers of the magnetic media." Office Action of July 17, 2002, page 5. However, Brosow does not teach or suggest a base layer, at least one magnetic layer, or an ink receptive layer. Specifically, the base material in Brosow is not a discrete layer upon which the other layers are adhered, the magnetic fibers or filaments do not form a layer, and an ink receptive layer is not disclosed.

The cited references also do not provide a motivation to combine. The Examiner states that it would have been obvious to modify Brosow "to include a printing media having the disclosed arrangement, as taught by Ohno, to provide a secure document that contains encoded information that can not be easily reproduced." Office Action of July 17, 2002, page 5. However, nothing in Brosow and Ohno suggests the desirability of such a combination. Furthermore, even if Brosow and Ohno were combined, the claimed invention would not be produced because the resulting magnetic layer would not comprise a layer of homogenous, magnetic material and the base layer, magnetic layer, and ink receptive layer would not be adhered to one another.

Dependent claims 11-15 include all the limitations of claim 10 and, therefore, are allowable, *inter alia*, as depending on allowable claim 10.

Claim 12 is further allowable because Brosow and Ohno do not teach or suggest that the magnetically encoded information is identical in content to the printed information.

Claim 13 is further allowable because the cited references do not teach or suggest that the magnetic layer and the ink receptive layer are adapted to record encoded information and printed information simultaneously.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejections to claims 10-15 is respectfully requested.

Obviousness Rejection Based on Brosow in View of Ohno and Further in View of Fryberg

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Brosow in view of Ohno and further in view of Fryberg. Applicant respectfully

submits that the cited references do not teach or suggest the limitations of claim 16 and do not provide a suggestion or motivation to combine. Claim 16 depends on claim 10 and, therefore, includes all the limitations of claim 10. As previously discussed, Brosow and Ohno do not teach or suggest a magnetic layer that comprises a layer of homogenous, magnetic material or a base layer, magnetic layer, and ink receptive layer that are adhered to one another. Fryberg also does not teach or suggest these limitations and, therefore, does not cure the deficiencies in Brosow and Ohno.

The cited references also do not provide a motivation to combine. The Examiner states that it would have been obvious to combine Ohno, Brosow, and Fryberg "to retain the printing received on the surface that would diminish over time without the use of the coating." Office Action of July 17, 2002, page 6. However, nothing in Brosow, Ohno, and Fryberg suggest the desirability of a base layer of a magnetic printing media having a coated surface adapted to increase ink receptivity. Furthermore, even if the cited references were combined, the claimed invention would not be produced because the resulting magnetic layer would not comprise a layer of homogenous, magnetic material and the base layer, magnetic layer, and ink receptive layer would not be adhered to one another.

In view of the foregoing arguments, reconsideration and withdrawal of the Section 103 rejections to claim 16 is respectfully requested.

CONCLUSION

In view of the foregoing amendments, and further in view of the arguments made, it is believed that this application is now in condition for allowance. Reconsideration and early Notice of Allowance is respectfully requested. Should the Examiner determine that additional issues remain that might be resolved by a telephone conference, she is respectfully invited to contact Applicant's undersigned attorney.

Respectfully Submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

IN THE SPECIFICATION:

Please insert the following paragraphs at page 3, lines 9-13:

FIG. 2 is a side view of an alternate embodiment of the magnetic printing media; [and]

FIG. 3 is an exploded perspective view that depicts the magnetic printing media with different information recorded on the magnetic layer and the ink receptive layer; and

FIG. 4 is a side view of an alternate embodiment of the magnetic printing media.

Please replace the paragraph on page 3, lines 20-25 with the following:

Referring to FIG. 1, the magnetic printing media **2** is comprised of three layers: a base layer **6**, a magnetic layer **8**, and an ink receptive layer **10**. Preferably, the magnetic printing media **2** is the size of a typical print media, such as paper commonly used in commercially-available printers (*e.g.*, 8 ½" x 11" paper, A4 paper, and 8 ½" x 14" paper). However, it is understood that the magnetic printing media **2** can be of any size that can be accommodated by any printer **[4]**.

Please replace the paragraph on page 4, line 27 through page 5, line 5 with the following:

The ink receptive layer **10** of the magnetic printing media **2** is capable of receiving printed images by absorbing ink deposited by a printer **[4]**. The printer is preferably a laser or inkjet printer, although any printing apparatus designed to deposit ink on a medium can be used with the present invention. Many different ink materials may be used in producing printed images on the ink receptive layer **10** of the magnetic printing media **2**. In this regard, the invention shall not be restricted to the generation of images using any particular ink product. However, at a minimum, the selected ink composition will include an ink vehicle and at least one coloring agent, with the term "coloring agent" being defined to encompass a wide variety of different dye materials and colors, including black, shades thereof, and/or a combination of various colors and black.

Please replace the paragraph on page 6, lines 19-24 with the following:

The information on each layer can be recorded simultaneously or at different times. The magnetic information and printed text may be recorded simultaneously by a device that has been modified to record magnetic information and print text and graphics. Alternatively, the information may be recorded at different times by recording the magnetic information onto the magnetic printing media **2** and then feeding the magnetic printing media **2** through the printer [**4**].

IN THE CLAIMS:

1. (Amended) A magnetic printing media for use in a laser and inkjet printer comprising:

a base layer;

at least one magnetic layer in contact with said base layer, said at least one magnetic layer adapted to record magnetically encoded information, wherein said at least one magnetic layer comprises a layer of homogenous, magnetic material; and

at least one ink receptive layer in contact with said at least one magnetic layer, said at least one ink receptive layer adapted to absorb laser or inkjet ink thereon.

2. (Amended) The magnetic printing media of claim 1, wherein said base layer supports said magnetic printing media and allows said magnetic printing media to be transported through either of said laser printer or said inkjet printer.

8. (Amended) The magnetic printing media of claim 1, wherein said magnetically encoded information [is identical to said] comprises textual and graphical information.

10. (Amended) A magnetic printing media used to verify the authenticity of a document, comprising:

a base layer;

at least one magnetic layer upon which magnetically encoded information is recorded, said at least one magnetic layer comprising a layer of homogenous, magnetic material, wherein said at least one magnetic layer is adhered to said base layer; and

at least one ink receptive layer upon which printed information is recorded, wherein said at least one ink receptive layer is adhered to said at least one magnetic layer and wherein said authenticity of said document is verified by determining whether said magnetic layer contains said magnetically encoded information.

17. (Amended) A method of making a magnetically encoded, printed document comprising:

providing a base layer that supports said magnetically encoded printed document;

adhering a magnetic layer to said base layer;

adhering an ink receptive layer to said magnetic layer;

recording magnetically encoded information on said magnetic layer; and

printing information on said ink receptive layer using an inkjet or laser printer.

19. (Amended) The method of claim 17, wherein said [recording said printed] printing information comprises transporting said magnetically encoded, printed document through [a] said inkjet or laser printer.